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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,026	02/15/2001	Yoshihide Iteya	57139-5045	3020

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EXAMINER

SMITH, JULIE KNECHT

ART UNIT PAPER NUMBER

3682

DATE MAILED: 04/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

Office Action Summary

Application No.

09/785,026

Applicant(s)

ITEYA, YOSHIHIDE

Examiner

Julie K Smith

Art Unit

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 27, 2003 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 6, 13, and 17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagano (4,489,307). Nagano discloses a bicycle control device for holding a computer switch having an operation control device, wherein the recess has a shape conforming to the outer periphery of the operation control button (55, see fig. 2). Nagano further discloses a cable mounting recess (22) therein in communication with the switch mounting recess, wherein the cable mounting recess extends from the switch mounting recess in the direction of the cycle computer, and wherein a portion of the connecting cable (58) is mounted in the cable mounting recess.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-5, 10-11 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagano as applied to claims 1, 6, 13, and 17 and 19 above, and further in view of Abe (6,073,730).

Regarding claims 3-5 and 14-16, Nagano does not disclose the control device being used as a braking and shifting device. However, Abe teaches a control device having two control buttons used for braking and shifting.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the control buttons of Nagano to be used to actuate shifting and braking as it is old and well known in the art to have control buttons used for braking and shifting.

Regarding claims 10-11, Abe discloses a retention ring (38) fastened to the casing and configured to restrict the movement of the control switch.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the control buttons of Nagano with the teachings of Abe to provide a retention ring around the control buttons so as to provide a more secure housing for the control buttons.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagano as applied to claims 1, 6, 13, and 17 and 19 above, and further in view of Seimitsu (JP 20026893).

Regarding claim 7, Nagano discloses a bicycle control device, as claimed, but does not disclose the control switch being attached in the switch mounting recess by an adhesive.

However, Seimitsu teaches using an adhesive to attach a portable clock to a fixed base.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to attach the control switch to the mounting recess using an adhesive so as to provide a secure connection between the switch and recess. Moreover, using an adhesive to attach one member to another is old and well known in the art and would have been obvious to one of ordinary skill in the art at the time the invention was made.

7. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagano as applied to claims 1, 6, 13, and 17 and 19 above, and further in view of Miyoshi et al. (JP 04048521).

Regarding claims 8-9 and 27, Nagano discloses a control device but does not disclose the switch mounting recess, as claimed. However, Miyoshi et al. teaches a switch mounting recess defining a hole (9a,b) therein, the control switch (12) having an attachment arm (13) made of an elastic material, wherein the attachment arm is press-fitted into the hole of the switch mounting recess. Miyoshi et al. further teaches an elastic cover (10) surrounding the control switch wherein the elastic cover is press-fitted into the recess and in frictional contact with and surrounded by a recess wall (see fig. 2).

Art Unit: 3682

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the control device of Nagano with the teachings of Miyoshi et al. to provide the switch with a press-fitted mounting so as to provide a more secure and stable form of attachment for the control device switch.

Moreover, claims 8 and 9 are product by process claims and even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagano in view of Abe et al. as applied to claims 3-5, 10-11 and 14-16 above, and further in view of Hill et al. (5,745,438).

The reference combination set forth above discloses a bicycle control device having a retention ring, but does not disclose a threadingly engaged retention ring. However, Hill et al. teaches a threaded retention ring used to secure a member (17) within a recess (32).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of the reference combination with the teachings of Hill et al. so as to provide a secure method of retaining the control switch within the recess that could withstand the rough conditions to which a bicycle might be exposed.

Art Unit: 3682

9. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagano in view of Iteya (6,331,089). Regarding claim 18, Nagano discloses a handlebar assembly comprising a handlebar having an end, a hand grip (1), a control device (see fig. 5) attached to the handlebar proximal the hand grip such that the rider's hand can reach the control device while remaining on the hand grip, the control device defining a switch mounting recess (4), and a control device (5) mounted in the recess. Abe does not disclose a cycle computer assembly, as claimed. However, Iteya discloses a cycle computer attached to a handlebar, separate from a control device with a connecting cable (22a,b) electrically connecting a control switch to the cycle computer (see fig. 2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a cycle computer attached to a handle bar connected by a cable to a separate control switch so as to allow the computer screen to be visible to the rider while keeping the controls close to the hand grip so that the rider does not have to move his hand to reach the controls.

10. Claims 20-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagano in view of Miyoshi et al. and Hill et al. Although the reference combination is silent concerning the particular method set forth in claims 20-26, the manufacture of the apparatus, as set forth in the reference combination above, would inherently lead to the method steps recited in claims 20-26. Defining the product in terms of a process by which it is made is nothing more than a permissible technique that Applicant may use to define the invention since no structural difference is required.

Response to Arguments

11. Applicant's arguments with respect to claims 1 and 3-27 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

4,071,892 to Genzling

5,553,007 to Brisson

5,737,247 to Baer et al.

5,177,432 to Waterhouse et al.

4,490,127 to Matsumoto et al.

4,641,723 to Takanashi et al.

4,638,448 to Cuvelier et al.

5,294,924 to Dyczyn

4,435,983 to Shimano

5,335,188 to Brisson

JP 06325667 to Hitachi

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K Smith whose telephone number is 703-305-3948. The examiner can normally be reached on Monday-Friday, 8-5:30, (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 703-308-3668. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Art Unit: 3682

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

jks
jks
April 28, 2003

[Signature] 4/28/03
DAVID A. BUCC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600